

REMARKS

This is a full and timely response to the outstanding final Office Action mailed November 1, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Allowable Subject Matter

Applicant appreciates the Examiner's indication that claims 9-18 are allowable over the prior art of record and that claims 20 and 21 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

In that it is believed that every rejection has been overcome, it is respectfully submitted that each of the claims that remains in the case is presently in condition for allowance.

II. Amendment Objection

The amendment filed February 2, 2006 has been object to under 35 U.S.C. § 132(a) as introducing new matter. In particular, it is argued that Applicant's original disclosure did not support the concept of a lack of sleeve, as recited in claim 32. Applicant disagrees with the objection.

The "new matter" objection is derived from 35 U.S.C. § 112, first paragraph, which has been interpreted as establishing the "written description" requirement. The purpose of the written description requirement of 35 U.S.C. § 112, first paragraph, is to ensure that the inventor had *possession*, as of the filing date of application relied upon, of the specific subject matter later claimed by him. *Application of Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976); *Application of Edwards*, 568 F.2d 1349, 1351, 196 USPQ 465, 467 (CCPA 1978). This possession requirement ensures that the applicant actually invented the later

claimed subject matter at the time the patent application was filed. As stated by the Court of appeals for the Federal Circuit (hereinafter “Federal Circuit”):

Satisfaction of the description requirement ensures that subject matter presented in the form of a claim subsequent to the filing date of the application was sufficiently disclosed at the time of filing so that a *prima facie* date of invention can fairly be held to be the filing date of the application.

Eiselstein v. Frank, 52 F.3d 1035, 1039, 34 USPQ 2d 1467, 1470 (Fed. Cir. 1995). With possession being the key to satisfying the written description requirements of 35 U.S.C. § 112, first paragraph, the test for establishing that adequate written description simply concerns showing evidence that such possession existed. As has been repeatedly stated by both the Court of Customs and Patent Appeals and the Federal Circuit:

[A]ll that is required is that it [the applicant] *reasonably conveyed* to persons skilled in the art that, as of the filing date thereof, the inventor had *possession* of the subject matter later claimed by him.

Eiselstein, 52 F.3d at 1039, 34 USPQ2d 1467, 1470 (emphasis added). *See also*, *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158, 47 USPQ2d 1829, 1832 (Fed. Cir. 1998) (“To meet this requirement, the disclosure of the earlier application, the parent, must reasonably convey to one of skill in the art that the inventor possessed the later-claimed subject matter at the time the parent application was filed”); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) (“The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.”); *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed.

Cir. 1985) (If adequate description support exists, the application relied upon “reasonably conveys to the artisan that the inventor had possession at the time of the later claimed subject matter.”). This legal precedent makes it clear that it is well-established, indeed axiomatic, that, to comply with written description requirement of 35 U.S.C. § 112, first paragraph, all that is required is that applicant “reasonably convey” to persons having ordinary skill in the art that, as of the filing date, the inventor possessed the subject matter at issue.

In the present case, Applicant clearly had possession of the claimed “integration isolation member is not provided around a sleeve” given that nowhere does Applicant describe or show such a sleeve in the original disclosure. In other words, Applicant has “reasonably conveyed” that Applicant’s fasteners do not include a sleeve. As such, Applicant believes that Applicant is entitled to explicitly claim that configuration. Applicant therefore has not canceled claim 32 and respectfully submits that the limitations of that claim must be considered.

III. Claim Rejections - 35 U.S.C. § 112, First Paragraph

Claim 32 has been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention at the time the application was filed.

For the reasons described in relation to Section II above, Applicant respectfully submits that the limitation “integration isolation member is not provided around a sleeve” does have basis in the original disclosure and that claim 32 is not improper under 35 U.S.C. § 112, first paragraph. Therefore, Applicant respectfully requests that the rejection be withdrawn.

IV. Claim Rejections - 35 U.S.C. § 102(b)

Claims 1-8 have been rejected under 35 U.S.C. § 102(b) as being anticipated by *Sihon* (U.S. Pat. No. 5,397,206). Applicant respectfully traverses this rejection.

As indicated above, independent claim 1 has been amended to include the limitation “wherein the isolation member includes a base portion having an outer wall and an axial portion extending from the base portion, the outer wall being adapted to abut the drive cage surface and the axial portion being configured to fit within the drive cage slot, wherein the base portion has a diameter that is larger than a diameter of the axial portion”. Applicant notes that that limitation is identical to now canceled claim 20, which the Examiner indicated as comprising allowable subject matter. In view of that, Applicant respectfully submits that claim 1 and its dependents are allowable over *Sihon* and requests that the rejections be withdrawn.

V. Claim Rejections - 35 U.S.C. § 103(a)

Claims 19 and 22-26 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Felcman, et al.* (“Felcman,” U.S. 6,122,173) in view of *Grassens, et al.* (“Grassens,” U.S. Pat. No. 4,683,520). Applicant respectfully traverses this rejection.

As indicated above, independent claim 19 has been amended to include the subject matter of claim 20, which the Examiner indicated as comprising allowable subject matter. In view of that amendment, Applicant respectfully submits that claim 19 and its dependents are allowable over *Felcman* and *Grassens* and requests that the rejections be withdrawn.

VI. Canceled Claims

Claims 3, 20, and 27-31 have been canceled from the application without prejudice, waiver, or disclaimer. Applicant reserves the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

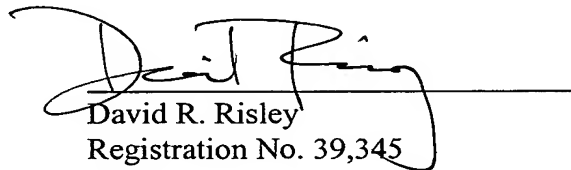
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CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

5/19/06
Stephanie Riley
Signature